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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,033	02/09/2001	Donald P. Gibson	36.P290	1583
5514	7590	04/20/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MYHRE, JAMES W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/781,033	GIBSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James W Myhre	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 January 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 47-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 47-54 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20010209</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on January 24, 2005 has been considered but is ineffective to overcome the Jackson et al (6,760,128) reference. The amendment amended Claims 47, 48, 51, and 52, and added Claims 53 and 54. Claims 1-46 were previously canceled by the Applicant in the July 28, 2004 reply to the restriction requirement. The currently pending claims considered below are Claims 47-54.

### *Claim Rejections - 35 USC § 101*

2. The amendment filed on January 24, 2005 amended independent Claim 47 to include technological references, thus overcoming the rejection of Claims 47-50 in paragraph 3 of the October 19, 2004 office action as being directed towards non-statutory subject matter under 35 U.S.C. 101. Therefore, the Examiner hereby withdraws that rejection.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 47-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Jackson et al (6,760,128).

Claims 47 and 52: Jackson discloses a system and method for providing digital image service, comprising:

- a. receiving digital image data from a removable storage media via an interface (col 3, line 59 – col 4, line 6);
- b. storing the digital image data in an electronic image database (col 4, lines 14-41);
- c. receiving advertising information (e.g. “describing different features of the albums and other photo products”) from a remote server via a network (col 4, lines 14-25)
- d. storing the received advertising information in an electronic advertising database (col 4, lines 14-41);
- e. receiving a request at a computer for displaying a service menu (col 8, lines 18-46);
- f. responsive to the request, sending the digital image data in the electronic image database and the advertising information in the electronic advertising database to the computer (col 8, lines 18-46); and
- e. displaying, in the service menu of the computer, an image based on the digital image data, an advertisement based on the advertising information, and one or more services for printing (col 6, line 66 – col 8, line 46).

Claim 48: Jackson discloses a method for providing digital image service as in Claim 47 above, and further discloses the menu includes the advertisement and thumbnail images of the image data (col 8, lines 18-46).

Claim 49: Jackson discloses a method for providing digital image service as in Claim 47 above, and further discloses the menu including selecting a size and volume of print for each of the selected image data (col 6, line 66 – col 8, line 46).

Claim 50: Jackson discloses a method for providing digital image service as in Claim 47 above, and further discloses the menu includes an option to generate a storage medium containing the selected image data (col 6, line 66 – col 8, line 46).

Claim 51: Jackson discloses a method for providing digital image service as in Claim 47 above, and further discloses the image data being captured and stored on the removable storage medium of a digital camera (col 3, line 65 – col 4, line 6).

Claims 53 and 54: Jackson discloses a method and system for providing digital image service as in Claims 47 and 52 above, and further discloses the digital image data and advertising information being sent to the computer via a cable head end (col 3, line 45 – col 4, line 25).

***Response to Arguments***

5. Applicant's arguments filed January 24, 2005 have been fully considered but they are not persuasive.
  - a. In response to the Applicant's request on page 5, a signed copy of the Information Disclosure Statement filed on February 9, 2001 is attached.
  - b. The Applicant argues that Jackson does not disclose displaying a service menu which includes the digital image data, advertising information, and one or more services for printing (page 6). However, the Examiner notes that Jackson explicitly discloses displaying thumbnails of the received digital images (which were received from a removable storage medium such as a digital camera), "albums and other photo products" such as "t-shirts, coffee mugs, etc." which the user may purchase (i.e. advertising information), and options (i.e. service menu) for printing a group of digital images onto album pages which includes "providing various background colors or textures, page numbers, page captions, image captions, etc.".

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

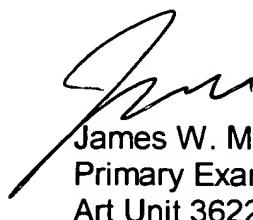
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Note: Effective April 2005, the examiner's telephone numbers will be changed to (571) 272-6722 (phone) and (571) 273-6772 (Informal faxes); and the examiner's supervisor's telephone number will be changed to (571) 272-6724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM  
April 11, 2005

  
James W. Myhre  
Primary Examiner  
Art Unit 3622